

## **REMARKS**

In the Office Action mailed July 23, 2008, the Examiner (1) subjected claim 27 to a restriction requirement and indicated that claim 27 was withdrawn from prosecution (2) rejected claims 1 and 26 under 35 U.S.C. § 112, ¶ 2 as being indefinite, (3) rejected claims 1-4, 14 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Glance et al., “One-THz Digital Random Access High Resolution Optical Frequency Synthesizer Providing Cold-Start Operation From A Frequency Reference” (referred to herein as “Glance”) in view of Li et al., U.S. Patent Application Pub. No. 2003/0007522 (referred to herein as “Li”), and (4) rejected claims 5, 18, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Glance in view of Li and Ackerman et al., U.S. Patent No. 6,535,532 (referred to herein as “Ackerman”).

The Examiner also objected to claims 7-13, 15-17, 20, and 21 as being dependent upon a rejected base claim, but stated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for indicating the allowable subject matter.

### **1. Status of the Claims**

Currently pending are claims 1-5, 8-17, 20-21, and 26 of which claims 1 and 26 are independent and the remainder are dependent. Applicants have amended claims 1, 20, and 26 in order to expedite allowance. Further, Applicants have withdrawn claim 27 and cancelled claims 7, 18, and 28 without prejudice, and reserve the right to pursue the subject matter of these claims in a continuing application.

## **2. Response to the Restriction Requirement**

As stated above, the Examiner subjected claim 27 to a restriction requirement. In this response, Applicants elect the group of claims other than claim 27 without prejudice and have withdrawn claim 27 from prosecution in accordance with the restriction requirement. Applicants reserve the right to pursue claim 27 at a later time, or in one or more divisional applications.

## **3. Response to 35 U.S.C. § 112, ¶ 2 Rejection**

The Examiner rejected claims 1 and 26 under 35 U.S.C. § 112, ¶ 2 as being indefinite. Specifically the Office Action states that “the examiner cannot determine whether ‘wavelength response’ refers to the laser or to the etalon”. Office Action, p. 3. In response, Applicants have amended claims 1 and 26 to recite “a resonance peak of the wavelength reference”. Accordingly, Applicants request that the § 112, ¶ 2 rejection of claims 1 and 26 be withdrawn.

## **4. Response to Claim Objections and Rejections Under 35 U.S.C. §§ 103**

Applicants have cancelled claims 18 and 28. Therefore, the § 103 rejections of claims 18 and 28 are moot.

In response to the Examiner's rejections of claim 1 and 26, Applicants have amended both independent claims 1 and 26 to include all of the limitations of claim 7, and Applicants have cancelled claim 7. As a result, both claims 1 and 26 now recite the subject matter of claim 7 that the Examiner indicated would be allowable in the Office Action. Office Action, p. 10. Therefore, claims 1 and 26 are allowable. Claims 2-5, 8-17, and 20-21 all depend ultimately from claim 1 and are thus allowable for at least the reason that they each depend from an allowable claim 1.

Applicants submit that claims 1-5, 8-17, 20-21, and 26 are new, non-obvious, and allowable. Accordingly, Applicants request the § 103(a) rejections be withdrawn. By making the amendments noted above, Applicants do not acquiesce in the claim rejections. However, Applicants have made the claim amendments without prejudice in order to expedite prosecution.

## 5. Conclusion

For the foregoing reasons, Applicants submit that all of the pending claims are now in condition for allowance, and thus Applicants respectfully request notice to that effect. Should the Examiner wish to discuss any aspect of this application, the Examiner is welcome to call the undersigned at (312) 913-3338.

Respectfully submitted,

Date: November 21, 2008

By: Thomas J. Loos/  
Thomas J. Loos  
Reg. No. 60,161

**McDonnell Boehnen Hulbert & Berghoff LLP**  
300 South Wacker Drive  
Chicago, Illinois 60606-6709